

GP 163)



July 27, 2000



Assistant Commissioner for Patents
Washington, DC 20231

Group Art Unit: 1631
Examiner: Y. Kim

Re: U.S. Utility Application No. 09/421,106
Filed: October 15, 1999
For: Nucleic Acid Molecules and Other Molecules Associated
with Plants
Inventor: Joseph R. BYRUM
Atty. Docket: 04983.0119.00US01/38-21(15598)B

Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office (PTO) are the following documents:

1. Response to Restriction Requirement; and
2. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038. A duplicate copy of this letter is enclosed.

Sincerely,

A handwritten signature consisting of two parts. The first part is a stylized "J" followed by "R" and "M". The second part is a stylized "J" followed by "E" and "C".

David R. Marsh (Reg. No. 41,408)
June E. Cohan (Reg. No. 43,741)

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Joseph R. BYRUM

Appl. No.: 09/421,106

Filed: October 15, 1999



Art Unit: 1631

Examiner: Y. Kim

Atty. Docket: 04983.0119.00US01/
38-21(15598)B

For: **Nucleic Acid Molecules and Other
Molecules Associated with Plants**

Response to Restriction Requirement

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In the Office Action mailed June 30, 2000, the Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

Group I: claims 1-10, drawn to substantially purified nucleic acids, classified in class 536, subclass 23.6;

Group II: claim 11, drawn to substantially purified proteins, classified in class 530, subclass 350; and

Group III: claims 12-15, drawn to transformed plants, classified in class 435, subclass 419.

Applicants respectfully traverse the restriction requirement, and provisionally elect the claims of Group I (claims 1-10) for further prosecution.

Applicants submit that the complete examination of the application would be most expeditiously handled by treating all of the pending claims as a single entity. As Section 803 of the MPEP states, “[i]f the search and examination of an entire application can be made

without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." It is respectfully submitted that the Examiner has not shown that a search and examination of the entire application would cause a serious burden. No serious burden is created when a simultaneous computerized search for the nucleic acids of Group I and the proteins of Group II is run, for example. A single search may be run, for example, in conjunction with databases such as those available at <http://www.ncbi.nlm.nih>. Rather, a serious burden would arise if the application were restricted.

Based on the foregoing, Applicants submit that the restriction requirement is improper and therefore must be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, Group I (claims 1-10) drawn to nucleic acid molecules.

The Office Action further requires that, in the event that Group I is elected, no more than 10 specific sequences may be specified for examination. In view of Applicants' provisional election of Group I, and in the event that the restriction requirement is made final, it is hereby requested that the following 10 sequences be examined in this application:

SEQ ID NO: 1;

SEQ ID NO: 2;

SEQ ID NO: 3;

SEQ ID NO: 4;

SEQ ID NO: 5;

SEQ ID NO: 6;

SEQ ID NO: 7;

SEQ ID NO: 8;

SEQ ID NO: 9; and

SEQ ID NO: 10.

However, the election of the above sequences is made with traverse. The Examiner's restriction to 10 sequences is improper. Examination of more than 10 sequences for the nucleic acids of claims 1 through 10 would not present an undue burden due to interrelationship between the disclosed sequences.

Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicant's undersigned representative at (202) 383-7093.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 08-3038.

Respectfully submitted,


David R. Marsh (Reg. No. 41,408)
June E. Cohan (Reg. No. 43,741)

Date: July 27, 2005

HOWREY SIMON ARNOLD & WHITE, LLP
Box No. 34
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2402
(202) 783-0800 telephone
(202) 383-6610 facsimile